UNITED STATES PATENT AND TRADEMARK OFFICE

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10/687,714	10/17/2003	Kyle Brown	RSW920030135US1	4641

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EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/687,714
Filing Date: October 17, 2003
Appellant(s): BROWN, KYLE

—————————
Mark D. Simpson
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

This is in response to the Remand by the Board of Patent Appeals and

Interferences mailed on 05/25/2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of

rejection to be reviewed on appeal. Every ground of rejection set forth in the Office

action from which the appeal is taken (as modified by any advisory actions) is being

maintained by the examiner except for the grounds of rejection (if any) listed under the

subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are

provided under the subheading "NEW GROUNDS OF REJECTION."

NEW GROUND(S) OF REJECTION

Claim 13 is rejected under 35 USC § 112, ¶ 2, as being indefinite for failing to

particularly point out and distinctly claim the subject matter which applicant regards as

the invention. The claim(s) recites/recite the following means (or step) plus function

limitation: means for identifying the occurrence of one or more alarm conditions.

This limitation invokes 35 USC § 112, ¶ 6 because it meets the 3-prong analysis

set forth in MPEP 2181 as it recites the phrase "means for" or "step for" (or appellant

identifies the limitation as a means (or step) plus function limitation in the appeal brief)

and the phrase is modified by functional language and it is not modified by sufficient

structure, material, or acts for performing the recited function. Also see *Altiris Inc. v.*

Semantec Corp., 318 F.3d 1363, 1375 (Fed. Cir. 2003). 35 USC § 112, ¶ 6, requires

such claim to be construed to cover the corresponding structure, material, or acts

described in the specification and equivalents thereof. "If one employs means plus

function language in a claim, one must set forth in the specification an adequate

disclosure showing what is meant by that language. If an applicant fails to set forth an

adequate disclosure, the applicant has in effect failed to particularly point out and

distinctly claim the invention as required by the second paragraph of section § 112." *In*

re Donaldson Co., 16 F.3d 1189, 1195, 29 USPQ 1845, 1850 (Fed. Cir. 1994)(in banc.).

For a computer-implemented means-plus-function claim limitation that invokes 35 USC

§ 112, ¶ 6, the corresponding structure is required to be more than simply a general

purpose computer. *Aristocrat Technologies, Inc. v. International Game Technology*,

521 F.3d 1328, 1333, 86 USPQ2d 1235, 1239-40 (Fed. Cir. 2008). The corresponding

structure for a computer-implemented function must include the algorithm as well as the

general purpose computer. *WMS Gaming,Inc. v. International Game Technology*, 184

F.3d 1339, 51

USPQ2d 1385 (Fed. Cir. 1999). The written description must at least disclose the

algorithm that transforms the general purpose microprocessor to a special purpose

computer programmed to perform the claimed function. *Aristocrat*, 521 F.3d at 1338, 86

USPQ2d at 1242.

In the instant application, the following portions of the specification and drawings may

appear to describe the corresponding structure for performing the claimed function:

Figure 1 depicts representative single user computer workstation 110 including

microprocessor 112.

Figure 2 depicts a data processing network 240 including a plurality of individual networks 242, 244 and a plurality of individual workstations/devices 210a, 210b, 210c. Networks 242, 244 may include gateway computer 246 and application server 247. Page 8, lines 3-4 recite that the "present invention may be used on a client computer or server in a networking environment, or on a standalone workstation." Page 8, lines 16-22 recite that the "workstation or client computer may be any type of computer processor, including laptop, handheld or mobile computers; vehicle-mounted devices; desktop computers; mainframe computers; etc., having processing… capabilities. The server, similarly, can be one of any number of different types of computer which have processing and communications capabilities."

However, the specification and drawings do not disclose sufficient corresponding structure, material or acts for performing the claimed function. It appears that the occurrence of one or more alarm conditions is identified by software operating on microprocessor 112 of representative single user computer workstation 110. However, the specification does not describe how the identification of the occurrence of one or more alarm conditions is determined. Specifically, the specification does not provide the algorithm for the claimed means for identifying the occurrence of one or more alarm conditions. The only reference to this step is a single line on page 11, which recites "a determination is made as to whether or not any alarm conditions have been met." As such, appellants have failed to adequately describe sufficient structure for performing the functions claimed.

Claim 13 is rejected under 35 USC § 112, ¶ 2, as being indefinite for failing to

particularly point out and distinctly claim the subject matter which applicant regards as

the invention. The claim(s) recites/recite the following means plus function limitation:

means for identifying the occurrence of one or more alarm conditions.

The claim limitation does not use the term "means for" or "step for" which triggers a

rebuttable presumption that 35 USC § 112, ¶ 6, does not apply. However, this

presumption may be rebutted if the claim limitation uses a term that is not an art-

recognized structure to perform the claimed function, the term is modified by functional

language, and the term is not modified by sufficient structure or material for performing

the claim function. *See Ex parte Rodriguez*, 92 USPQ2d 1395, 1404-1406 (Bd. Pat.

App. & Int. 2009).

Here, appellant's claim limitation begins with a term followed by functional language and

the term is not modified by sufficient structure or material for performing the claimed

function. Furthermore, the specification does not provide a description sufficient to

inform one of ordinary skill in the art the meaning of the term; and the term is not an art-

recognized structure to perform the claimed function. Accordingly, the limitation invokes

35 USC § 112, ¶ 6.

35 USC § 112, ¶ 6, requires such claim to be construed to cover the corresponding

structure, material, or acts described in the specification and equivalents thereof. "If

one employs means plus function language in a claim, one must set forth in the

specification an adequate disclosure showing what is meant by that language. If an

applicant fails to set forth an adequate disclosure, the applicant has in effect failed to

particularly point out and distinctly claim the invention as required by the second

paragraph of section § 112." *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ 1845,

1850 (Fed. Cir. 1994)(in banc.). For a computer-implemented means-plus-function

claim limitation that invokes 35 USC § 112, ¶ 6, the corresponding structure is required

to be more than simply a general purpose computer. *Aristocrat Technologies, Inc. v.*

International Game Technology, 521 F.3d 1328, 1333, 86 USPQ2d 1235, 1239-40 (Fed.

Cir. 2008). The corresponding structure for a computer-implemented function must

include the algorithm as well as the general purpose computer. *WMS Gaming,Inc. v.*

International Game Technology, 184 F.3d 1339, 51 USPQ2d 1385 (Fed. Cir. 1999).

The written description must at least disclose the algorithm that transforms the general

purpose microprocessor to a special purpose computer programmed to perform the

claimed function. *Aristocrat*, 521 F.3d at 1338, 86 USPQ2d at 1242.

In the instant application, the following portions of the specification and drawings may

appear to describe the corresponding structure for performing the claimed function:

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microprocessor 112.

Figure 2 depicts a data processing network 240 including a plurality of individual networks 242, 244 and a plurality of individual workstations/devices 210a, 210b, 210c. Networks 242, 244 may include gateway computer 246 and application server 247. Page 8, lines 3-4 recite that the "present invention may be used on a client computer or server in a networking environment, or on a standalone workstation." Page 8, lines 16-22 recite that the "workstation or client computer may be any type of computer processor, including laptop, handheld or mobile computers; vehicle-mounted devices; desktop computers; mainframe computers; etc., having processing... capabilities. The server, similarly, can be one of any number of different types of computer which have processing and communications capabilities."

However, the specification and drawings do not disclosure sufficient corresponding structure for performing the claimed function. It appears that the occurrence of one or more alarm conditions is identified by software operating on microprocessor 112 of representative single user computer workstation 110. However, the specification does not describe how the identification of the occurrence of one or more alarm conditions is determined. Specifically, the specification does not provide the algorithm for the claimed means for identifying the occurrence of one or more alarm conditions. The only reference to this step is a single line on page 11, which recites "a determination is made as to whether or not any alarm conditions have been met." As such, appellants have failed to adequately describe sufficient structure for performing the functions claimed.

END NEW GROUNDS OF REJECTION

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2005/0010494	Mourad et al.	1-2005
7,107,225	McClung, III	9-2006
2002/0143655	Elston et al.	10-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

NEW GROUND(S) OF REJECTION

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particularly point out and distinctly claim the subject matter which applicant regards as

the invention. The claim(s) recites/recite the following means (or step) plus function

limitation: means for identifying the occurrence of one or more alarm conditions.

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set forth in MPEP 2181 as it recites the phrase "means for" or "step for" (or appellant

identifies the limitation as a means (or step) plus function limitation in the appeal brief)

and the phrase is modified by functional language and it is not modified by sufficient

structure, material, or acts for performing the recited function. Also see *Altiris Inc. v.*

Semantec Corp., 318 F.3d 1363, 1375 (Fed. Cir. 2003). 35 USC § 112, ¶ 6, requires

such claim to be construed to cover the corresponding structure, material, or acts

described in the specification and equivalents thereof. "If one employs means plus

function language in a claim, one must set forth in the specification an adequate

disclosure showing what is meant by that language. If an applicant fails to set forth an

adequate disclosure, the applicant has in effect failed to particularly point out and

distinctly claim the invention as required by the second paragraph of section § 112." *In*

re Donaldson Co., 16 F.3d 1189, 1195, 29 USPQ 1845, 1850 (Fed. Cir. 1994)(in banc.).

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structure for a computer-implemented function must include the algorithm as well as the

general purpose computer. *WMS Gaming,Inc. v. International Game Technology*, 184

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computer programmed to perform the claimed function. *Aristocrat*, 521 F.3d at 1338, 86

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In the instant application, the following portions of the specification and drawings may

appear to describe the corresponding structure for performing the claimed function:

Figure 1 depicts representative single user computer workstation 110 including

microprocessor 112.

Figure 2 depicts a data processing network 240 including a plurality of individual

networks 242, 244 and a plurality of individual workstations/devices 210a, 210b, 210c.

Networks 242, 244 may include gateway computer 246 and application server 247.

Page 8, lines 3-4 recite that the "present invention may be used on a client computer or

server in a networking environment, or on a standalone workstation."

Page 8, lines 16-22 recite that the "workstation or client computer may be any type of

computer processor, including laptop, handheld or mobile computers; vehicle-mounted

devices; desktop computers; mainframe computers; etc., having processing…

capabilities. The server, similarly, can be one of any number of different types of

computer which have processing and communications capabilities."

However, the specification and drawings do not disclose sufficient corresponding

structure, material or acts for performing the claimed function. It appears that the

occurrence of one or more alarm conditions is identified by software operating on

microprocessor 112 of representative single user computer workstation 110. However,

the specification does not describe how the identification of the occurrence of one or

more alarm conditions is determined. Specifically, the specification does not provide

the algorithm for the claimed means for identifying the occurrence of one or more alarm

conditions. The only reference to this step is a single line on page 11, which recites "a

determination is made as to whether or not any alarm conditions have been met." As

such, appellants have failed to adequately describe sufficient structure for performing the functions claimed.

Claim 13 is rejected under 35 USC § 112, ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim(s) recites/recite the following means plus function limitation: means for identifying the occurrence of one or more alarm conditions.

The claim limitation does not use the term "means for" or "step for" which triggers a rebuttable presumption that 35 USC § 112, ¶ 6, does not apply. However, this presumption may be rebutted if the claim limitation uses a term that is not an art-recognized structure to perform the claimed function, the term is modified by functional language, and the term is not modified by sufficient structure or material for performing the claim function. *See Ex parte Rodriguez*, 92 USPQ2d 1395, 1404-1406 (Bd. Pat. App. & Int. 2009).

Here, appellant's claim limitation begins with a term followed by functional language and the term is not modified by sufficient structure or material for performing the claimed function. Furthermore, the specification does not provide a description sufficient to inform one of ordinary skill in the art the meaning of the term; and the term is not an art-recognized structure to perform the claimed function. Accordingly, the limitation invokes 35 USC § 112, ¶ 6.

35 USC § 112, ¶ 6, requires such claim to be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. "If one employs means plus function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section § 112." *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ 1845, 1850 (Fed. Cir. 1994)(in banc.). For a computer-implemented means-plus-function claim limitation that invokes 35 USC § 112, ¶ 6, the corresponding structure is required to be more than simply a general purpose computer. *Aristocrat Technologies, Inc. v. International Game Technology*, 521 F.3d 1328, 1333, 86 USPQ2d 1235, 1239-40 (Fed. Cir. 2008). The corresponding structure for a computer-implemented function must include the algorithm as well as the general purpose computer. *WMS Gaming,Inc. v. International Game Technology*, 184 F.3d 1339, 51 USPQ2d 1385 (Fed. Cir. 1999). The written description must at least disclose the algorithm that transforms the general purpose microprocessor to a special purpose computer programmed to perform the claimed function. *Aristocrat*, 521 F.3d at 1338, 86 USPQ2d at 1242.

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Figure 1 depicts representative single user computer workstation 110 including

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networks 242, 244 and a plurality of individual workstations/devices 210a, 210b, 210c.

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capabilities. The server, similarly, can be one of any number of different types of

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structure for performing the claimed function. It appears that the occurrence of one or

more alarm conditions is identified by software operating on microprocessor 112 of

representative single user computer workstation 110. However, the specification does

not describe how the identification of the occurrence of one or more alarm conditions is

determined. Specifically, the specification does not provide the algorithm for the

claimed means for identifying the occurrence of one or more alarm conditions. The only

reference to this step is a single line on page 11, which recites "a determination is made

as to whether or not any alarm conditions have been met." As such, appellants have

failed to adequately describe sufficient structure for performing the functions claimed.

END NEW GROUNDS OF REJECTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-6, 8-27 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Mourad et al. (US 2005/0010494) in view of McClung, III (US 7,107,225).

Claim 1.

Mourad et al. (hereinafter Mourad) teaches a method for Internet e-commerce

shopping guide comprising:

identifying said one or more commodities using one or more searchable

identification parameters [0007], [0050];

monitoring a publicly-searchable, network-accessible databases for acquisition

parameters for said one or more commodities using said one or more searchable

identification parameters [0050]; and

outputting results of said monitoring step [0050].

Mourad does not explicitly teach that said publicly-searchable database includes a *plurality* of publicly-searchable databases.

McClung teaches monitoring *all vendors* of identified items (col. 1, line 54), thereby suggesting a "plurality" feature.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mourad to include that publicly-searchable database includes a *plurality* of publicly-searchable databases, as suggested in McClung, because it would advantageously allow to obtain the widest possible range of prices to find the lowest price.

Mourad also does not teach defining a monitoring duration during which acquisition parameters for said one or more commodities will be monitored.

McClung teaches a computer-implemented method for guaranteeing a consumer a best price on an item including monitoring all vendors of an item for a preset time period (col. 1, lines 37-39; col. 1, lines 54-55).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mourad to include defining a monitoring duration during which acquisition parameters for said one or more commodities will be monitored, as disclosed in McClung, because it would advantageously allow a consumer the assurance that the consumer will not buy an item or service and then find out in the near future that the item or service was made available at a much lower price, as disclosed in McClung (col. 1, lines 22-25).

Claim 2. Mourad teaches said method, wherein said one or more publicly-searchable databases includes shop-bot sites [0050].

Claim 3. Mourad teaches defining an overall duration for conducting said monitoring step; and defining a refresh interval for said monitoring step [0052].

Claim 4. Mourad teaches said method further comprising the step of: identifying one or more alarm conditions; and wherein said monitoring step further comprises at least the step of identifying the occurrence of one or more of said alarm conditions [0050].

Claim 5. Mourad teaches said method wherein said outputting step comprises at least the steps of: sending an email to a user of said method upon the occurrence of one or more of said alarm conditions [0050].

Claim 6. Mourad teaches said method wherein said outputting step comprises at least the steps of: sending an electronic page to a user of said method upon the occurrence of one or more of said alarm conditions [0031].

Claim 8. Mourad teaches said method wherein one of said one or more alarm conditions comprises an acquisition parameter reaching a predefined minimum value [0050].

Claim 9. Mourad teaches said method wherein said acquisition parameter comprises a sale price [0042].

System claims 10-15, 17-18 repeat the subject matter of method claims 1-9 respectively, as a set of apparatus elements rather than a series of steps. As the underlying processes of claims 1-9 have been shown to be fully disclosed by the teachings of Mourad, and McClung in the above rejections of claims 1-9, it is readily apparent that the system disclosed by Mourad, and McClung includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claims 1-9, and incorporated herein.

Claims 19-24, 26-27 are rejected on the same rationale as set forth above in Claims 1-9.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Mourad and McClung teachings, as applied to claim 1, and further in view of Elston et al. (hereinafter Elston) (US 2002/0143655).

The combination of Mourad and McClung teaches all the limitations of claim 7 except sending an instant message to a user of said method upon the occurrence of one or more of said alarm conditions.

Elston teaches a remote ordering system for mobile commerce wherein the notification can be sent by an instant message [0674].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mourad and McClung to include sending an instant message to a user of said method upon the occurrence of one or more of said alarm

conditions, as disclosed in Elston, because it would advantageously allow to avoid any delays in delivering time sensitive information.

System claim 16 repeats the subject matter of method claim 7, as a set of apparatus elements rather than a series of steps. As the underlying processes of claim 7 have been shown to be fully disclosed by the teachings of Mourad, McClung and Elston in the above rejections of claim 7, it is readily apparent that the system disclosed by Mourad, McClung and Elston includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claim 7, and incorporated herein.

Claim 25 is rejected on the same rationale as set forth above in Claim 7.

(10) Response to Argument

Applicant argues that Mourad, McClung and Elston fail to disclose monitoring a plurality of public databases to find a user selected commodity using one or more user selected acquisition parameters.

In response to this argument Examiner points out that Mourad discloses monitoring different retailers and alerting end user to the available inventory for a particular product [0054].

Since Mourad did not explicitly teach monitoring a plurality of public databases, McClung was applied to show said feature.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

Conclusion to Examiner's Answer Raising New Grounds of Rejection

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above.

Accordingly, appellant must within TWO MONTHS from the date of this answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the new ground of rejection:

(1) Reopen prosecution. Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) Maintain appeal. Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO

MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to

reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex

parte reexamination proceedings.

Respectfully submitted,

/Mila Airapetian/

Mila Airapetian
Primary Examiner
Art Unit 3625

A Technology Center Director or designee must personally approve the new

ground(s) of rejection set forth in section (9) above by signing below:

/Wynn Coggins/
Director, TC 3600

Conferees:

Vincent Millin /vm/
Appeals Conference Specialist, TC 3600

Jeffrey A. Smith /jas/
Supervisory Patent Examiner, Art Unit 3625